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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,048	07/30/2001	Timothy J. O'Brien	D6223CIP/A/D/CIP	4713

7590 03/19/2004

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EXAMINER

HARRIS, ALANA M

ART UNIT PAPER NUMBER

1642

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/919,048

Applicant(s)

O'BRIEN ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 22 and 24-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment and Arguments

1. Claims 1-18, 22 and 24-31 are pending.

Claims 1-17 and 24-31, drawn to non-elected inventions are withdrawn from examination.

Claim 18 has been amended.

Claims 18 and 22 are examined on the merits.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Withdrawn Objection

Specification

3. The first line of the specification has been amended to reflect the current status of all co-pending applications.

Withdrawn Rejection

Claim Rejections - 35 USC § 112

4. The rejection of claims 18 and 22 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is withdrawn in light of the amendment to claim 18.

Maintained Grounds of Rejection

Claim Rejections - 35 USC § 103

5. The rejection of claims 18 and 22 under 35 U.S.C. 103(a) as being unpatentable over Paglia et al. (J. Exp. Med. 183: 317-322, January 1996), in view of U.S. Patent number 6,232,456 (filed October 6, 1997) is maintained.

Applicants submit that "U.S. Patent 6,232,456 teaches a hepsin peptide which is 17 amino acids long (SEQ ID NO: 67, Figure 3A-2)" and "[i]n contrast, claim 18 is drawn to a 9 amino acids-long hepsin peptide with SEQ ID NO: 28 or 148. Therefore, U.S. Patent No. 6,232,456 teaches away from the present invention, and U.S. Patent No. 6,232,456 does not teach or suggest the use of a 9 amino acids-long hepsin peptide with SEQ ID NO: 28 or 148 as disclosed herein." These arguments and points of view have been carefully considered, but found unpersuasive.

In view of the open language, "...hepsin fragment ***having the sequence*** of SEQ ID NO: 28 or 148" in claim 18 the prior art continues to read on the claims. While patent '456 does teach a peptide that is 17 amino acids long this peptide encompasses the 9 amino acids-long hepsin peptides of SEQ ID NO: 9 and 148. The dendritic cells exposed to the hepsin peptide of patent '456 would intrinsically be exposed to the 9 amino acids-long hepsin peptides of SEQ ID NO: 9 and 148. For the reasons of record the rejection and reiterated above the rejection is maintained.

Double Patenting

6. Applicants assert they have submitted a terminal disclaimer (TD) to obviate the pending provisional rejection. The Examiner has reviewed all the papers submitted with the Remarks on January 12, 2004 and the TD does not accompany the papers.

Accordingly, claims 18 and 22 of this application continue to conflict with claims 14-23 of Application No. 10/102,283 (filed March 20, 2003) 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

7. The provisional rejection of claims 8 and 22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-23 of copending Application No. 10/102,283 (filed March 20, 2002) is maintained.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is (571)272-0831. The Examiner works a flexible schedule. In general she may be reached on 7:00 am to 4:30 pm, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne "Bonnie" Eyler, Ph.D. can be reached on (571)272-0871. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1642

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALANA M. HARRIS, PH.D.
PRIMARY EXAMINER


Alana M. Harris, Ph.D.
16 March 2004